

REMARKS

Claims 3, 5, 6, and 10-12 are pending in this application. Claims 3, 5, 6, and 10-12 stand rejected. In light of the remarks set forth below, Applicant respectfully submits that each of the pending claims is in immediate condition for allowance.

Paragraph 4 of the Office Action rejects claims 3, 5, 6, and 10-12 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,797,125 (“Hirohama”) in view of U.S. Patent No. 5,754,430 (“Sawada”). Applicant respectfully requests reconsideration and withdrawal of this rejection.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or combine references to arrive at the claimed subject matter. The prior art references must also teach or suggest all the limitations of the claim in question. See, M.P.E.P. § 706.02(j). A reference can only be used for what it clearly discloses or suggests. See, In re Hummer, 113 U.S.P.Q. 66 (C.C.P.A. 1957); In re Stencel, 4 U.S.P.Q.2d 1071, 1073 (Fed. Cir. 1987). Here, the references, whether taken individually or in combination, do not disclose or suggest the invention claimed by the Applicant.

As claims 3 and 10 are the only independent claims currently pending in the present application, Applicant is only addressing those claims with regard to the present rejections.

As previously discussed, contrary to the Examiner's position, Hirohama fails to disclose Applicant's explicitly recited storage medium storing the plurality of voice messages, the voice messages being in a plurality of languages organized in classes according to a language of the voice message data.

The Office Action asserts that this feature is shown in Figure 2 and 3 and the corresponding description at column 3, lines 15-29 and 43-52. However, this is incorrect. Figure 2 shows a terminal unit 4A having storage means 12. The storage means 12 includes "specific pieces of guide information for individual booths 2A to 2N each stored in any one of more than 1 language (any one of various languages such as Japanese, English, German, and French) in a compressed or non-compressed state." Further, when discussing Figure 3, the disclosure states that control center 5 writes into the storage means 12 in a particular language. Column 3, line 48. In fact, the patent gives as an example that "for example, Japanese for storage means 12 in the terminal unit 4A, English for the storage means 12 in the terminal unit 4B, German for the storage means 12 in the terminal 4N, etc." Thus, it is clear that in Hirohama, only a single language is stored on the data storage medium and not the plurality of languages explicitly recited in Applicant's claim. As such, Applicant respectfully submits that claims 3, 5, 6, and 10-12 are allowable over Hirohama in view of Sawada.

Sawada was added to show a removable storage medium. However, Sawada fails to disclose that data is stored in multiple languages. As such, Sawada fails to cure the deficiency in Hirohama discussed above.

Paragraph 5 of the Office Action rejects claims 3 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Hirohama in view of U.S. Patent No. 5,835,854 (“Palisson”). Applicant respectfully requests reconsideration and withdrawal of this rejection.

The Office Action asserts that the memory 23 contains a plurality of voice message data in a plurality of languages. Applicant respectfully disagrees. The memory card 23 corresponds to a data field. This memory contains data in various languages corresponding to the user’s nationality and/or to one or more given districts. However, this does not mean that memory card 23 contains a plurality of voice message data as explicitly recited in Applicant’s claim. In fact, Palisson, while able to store multiple languages, announces the words “in either one of the two languages.” Column 1, lines 45-48. Further, in the summary of the invention, it should be noted that the Palisson system utilizes two separate memory areas, each corresponding to a separate language. Thus, if multiple languages are required, multiple different memory areas are utilized.

In contrast, Applicant utilizes a single storage medium containing voice message data being in a plurality of languages. This feature is not disclosed in Palisson as discussed above. Therefore Applicant respectfully requests reconsideration and withdrawal of the present rejection.

Additionally, the Examiner must set forth a motivation to combine the Palisson and Hirohama references. Here, the Examiner has failed to set forth a proper motivation to combine. The Office Action first asserts that one would

modify Hirohama which provides a voice guide system with Palisson which provides a traffic information system. However, it is unclear why one would be motivated to do that. In Hirohama, various pieces of guide information are relayed to a user based on input signals along a route. In contrast, in Palisson, messages are relayed to a user so that route information would be translated into a user's native tongue or into the language of a given district. It is unclear what the Office Action's position is when it states that it is evident that a person skilled in the art would have known to adapt this description to the case of a navigation system or routing system, because the part that implements the invention may be the same both in a car radio and in a navigation system. It is unclear how that would teach one skilled in the art to adapt a voice guide such as the one shown in Hirohama with the radio data system disclosed in Palisson. For this additional reason, Applicant respectfully requests reconsideration and withdrawal of this rejection.

Paragraph 6 of the Office Action rejects claims 3 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Hirohama in view of Maruyama and further in view of U.S. Patent No. 6,647,251 ("Siegle"). Applicant respectfully request reconsideration and withdrawal of this rejection.

As discussed above, Hirohama fails to disclose a voice message data storage medium storing the plurality of voice message data, the voice message data being in a plurality of languages asserted on page 12 of the Office Action. Further, the Office Action asserts that Maruyama discloses a attachable and detachable voice message data storage medium storing the plurality of voice message data, the voice message data being in a plurality of languages. The Office Action asserts that this is

disclosed in Figure 12 and col. 16, lns. 15-42. However, Applicant respectfully disagrees. The portable terminal 143 in Maruyama does not include an attachable and detachable storage medium including the voice message data, the voice message data being in a plurality of languages. The portable terminal in Maruyama receives audio files stored in audio response equipment 21. As such, the portable terminals do not include a storage medium or the voice message data explicitly recited in Applicant's claim.

Siegle was included for the disclosure that a solid state chip card can be removably inserted. However, Siegle fails to cure the deficiencies in Hirohama and Maruyama discussed above.

Further, the piecemeal application of unrelated features of unrelated documents that has been used in this case to meet the features of the claims of the present application is objected to. To support a *prima facie* case of obviousness requires, among other things, that a motivation be identified, in the prior art itself, that would have caused one of skill in the art to make any proposed modification of the primary reference or to combine references. Further, if more than two references are combined, the motivation must be to combine *all three references*. This is because there must be a motivation to make the *two-fold modification* of the primary reference.

In the Office Action, the Examiner took the position that it would have been obvious to combine Hirohama with Maruyama to provide an attachable and detachable storage medium (Office Action at 13). However, Maruyama does not

disclose this feature as discussed above and the Examiner took the position that it would have been obvious to include the above features of because it would “the carrier can listen to the explanation at the selected information depth with the desired degree of detailedness of explanation.” This motivation does not address the multiple languages stored on a removable media recited in the claims nor does it provide motivation to modify Hirohama.

Moreover, the Office Action is equally deficient in the motivation provided for making the *further* modification to allegedly meet the feature of the removable storage media. It is conceded in the Action that even when combined, Hirohama and Maruyama do not teach this feature. Siegle is cited as remedying this deficiency. The motivation provided is that “data memory is easily exchangeable for updating.”

However, it is not sufficient in a three-way combination to provide motivation in a step-wise or serial manner. There must have been motivation in the prior art, and that motivation must be identified by the Examiner, to combine *all of the references* to meet the claim *as a whole*. The motivation provided in the Office Action for the additional modification to include the features of Siegle is stated in terms of why it would have been obvious to modify *the combination* of Hirohama and Maruyama, treating that combination as a given, and thus fails to provide the required motivation.

By treating the initial combination as a given, the motivation provided for the further modification is not sufficient since it does not even allege to constitute

motivation to make *the entire combination*. The motivation provided is completely deficient at least because it is a motivation to modify a hypothetical construct, namely the combination of Hirohama and Maruyama, that is, a motivation to modify something that does not exist. For this additional reason, no *prima facie* case of obviousness was set forth in the Office Action.

Applicant has responded to all of the rejections and objections recited in the Office Action. Reconsideration and a Notice of Allowance for all of the pending claims are therefore respectfully requested.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

If the Examiner believes an interview would be of assistance, the Examiner is welcome to contact the undersigned at the number listed below.

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Respectfully submitted,

By _____

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